

REMARKS

This paper is filed in response to the Official Action mailed November 4, 2004 for the above-captioned application. Reconsideration of the application, as amended, is respectfully requested.

Applicants have amended claim 30 to correct a clerical error, namely, to make it dependant from claim 19 instead of claim 50. This is believed to overcome Examiner's 35 USC 112 rejection of the claim.

The Examiner rejected claims 1-8, 10-12, 18-26, 28, 29-38, 40, and 42-45 under 35 USC § 102 (e) as being anticipated by Nagai et al., (US Pub 2004/0063825). Applicants respectfully disagree with Examiner and believe that Nagai does not anticipate the present invention. Nagai does not disclose at least two limitations contained within the present claims.

The claims of the present application contain the limitation, "wherein monomer residue (a) is a quinone structure, or a structure capable of forming a quinone structure upon oxidation." See all independent claims, namely claims 1, 44, and 45, and hence *see also* all dependant claims. Examiner cites Nagai saying that Nagai's formula 4 is representative of a compound capable of forming a quinone structure upon oxidation. Applicants respectfully disagree with Examiner and submit that Nagai's formula 4 is simply a bisphenol, similar to the bisphenol of structure IV of the present application (i.e. a structure suitable for monomer (b)). The Examiner has not explained how a bisphenol can be considered a quinone structure or capable of forming a quinone structure upon oxidation as required in each and every claim of the present application. See present application at page 7 last paragraph to page 11 first full paragraph. See also all claims of the present application.

The claims of the present application also contain the limitation of timing the addition of the catalyst. Applicants have searched and have found no mention in the cited reference of language disclosing timing the addition of the catalyst as required by the present claims. Applicants respectfully request Examiner to point to where in the Nagai reference such language may be found or to withdraw her 102 (e) rejection of the claims.

Applicants acknowledge Examiner's statement that claims 9, 13-17, 27, 39, and 41 are objected to and would be allowable if rewritten in independent form. However, Applicants

submit that these claims are allowable as they stand now in view of the above remarks.

Response to Provisional Double Patenting Rejection:

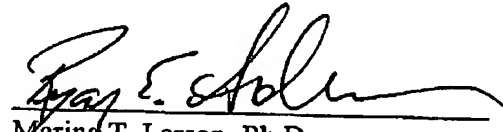
Examiner also issued a provisional double patenting rejection in view of Application No. 10/925833. Applicants respectfully disagree with Examiner and request that this rejection be withdrawn. In making the double patenting rejection the Examiner must take into account *only* the scope of the claims of the applications. *See* MPEP 806.01. The claims of the two applications are distinct and non-coextensive in scope. *See* MPEP 804.02 (I). They independently provide patentable solutions to the problem of color formation.

The claims of the present application require selecting a catalyst introduction strategy from a group of strategies outlined in the independent claims and implementing the selected strategy within the process to minimize the color of the resulting polycarbonate. The claims of the cited '833 application on the other hand contain the limitation of adding an antioxidant to the reaction mixture to reduce the color of the resulting polycarbonate. While the '833 application contains language with regard to introducing catalysts according to a selected strategy, the statement is made *with the proviso* that the antioxidant is also added to the reaction mixture. Thus, the claims are distinct and non-coextensive in scope and do not provide a basis for issuing a double patenting rejection.

If the applications were filed together as one application the Examiner would have been correct to issue a restriction requirement restricting out one invention from the other. In fact this was taken into consideration when filing the applications separately. MPEP section 806.05 (c) outlines the criteria for determining whether a restriction requirement is proper. In particular, two inventions are distinct if it can be shown that a combination as claimed: (a) does not require the particulars of the sub-combination as claimed for patentability (to show novelty and unobviousness), and (b) the subcombination can be shown to have utility either by itself or in other and different relations. Applicants submit, that the two applications do not require the other to show novelty and unobviousness and that in each application stands independently and is claimed as such. Thus, Applicants respectfully request Examiner to withdraw her double patenting rejection.

In view of the foregoing amendment and remarks, Applicants submit that the claims are patentable over the cited references. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited. No fee is believed to be due with the filing of this paper, however the Commissioner is authorized to charge any fee deemed due to Deposit Account 07-0862.

Respectfully Submitted,



Marina T. Larson, Ph.D

Reg. No. 32,038

Ryan E. Anderson

Reg. No. 51,405

Attorneys for Applicant(s)

(970) 468 6600